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REMARKS/ARGUMENTS

Applicant has studied the Office Action dated February 23, 2007 and has made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1-24 are pending. Claims 1, 10, and 18 are amended. No new matter has been added. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner:

- (Page 3) rejected claims 1, 6-7, 10-12, and 15 under 35 U.S.C. § 102(b) as being anticipated by Hoh et al. (U.S. Patent No. 4,232,068);
- (Page 5) rejected claims 1-2 and 9 under 35 U.S.C. § 102(b) as being anticipated by Colt (U.S. Patent No. 1,552,912);
- (Page 6) rejected claims 18-19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Hoh et al. (U.S. Patent No. 4,232,068);
- (Page 7) rejected claims 4, 8, 13, and 16 under 35 U.S.C. § 103(a) as being unpatentable over Hoh et al. (U.S. Patent No. 4,232,068) in view of Grove Products, Inc.;
- (Page 8) rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Colt (U.S. Patent No. 1,552,912) in view of Hartin (DES 423,909);
- (Page 8) rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Hoh et al. (U.S. Patent No. 4,232,068) in view of Colt (U.S. Patent No. 1,552,912);
- (Page 9) stated that claims 14 would be allowable if rewritten in independent form; and
- (Page 9) allowed claims 21-24.

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(Page 9) Allowable Subject Matter

The Applicant wishes to thank Examiner Laux for indicating the allowable subject matter of claim 14 and the allowance of claims 21-24 in their current state.

Since claim 14 depends from newly amended claim 10, and dependent claims contain all the limitations of the independent claim from which it depends, Applicant has elected not to rewrite claim 14 in independent form and instead rely on the distinguishing features of the present invention, as recited in the new amendments, to overcome the Examiner's rejections in light of the cited art.

(Pages 3) Rejection under 35 U.S.C. §102(b), Hoh et al.

As noted above, the Examiner rejected claims 1, 6-7, 10-12, and 15 under 35 U.S.C. § 102(b) as being anticipated by Hoh et al. (U.S. Patent No. 4,232,068). Claims 1 and 10 have been amended to distinguish and to more clearly define the present invention over Hoh et al. Support for the changes is found, *inter alia*, on pages 20 and 21 of the specification of the instant application. No new matter has been added.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Amended independent claims 1 and 10 recite, *inter alia*:

... arms defining a slot there between and having a transverse extent and a longitudinal extent that is longer than the transverse extent and extending longitudinally from the body portion, each arm having a wave shape, the shape and direction of the wave of each arm traveling along the longitudinal extent and wherein the arms are of a thickness and of a material that allows them to compress and elastically return substantially to their initial wave shape after a compressive force is removed. (emphasis added)

The present invention is a shim for windows, doors, and other similar applications. The inventive shim provides compressible wave-shaped arms that allow it to secure itself in openings of various widths. Instant specification, para. 0049. Specifically, the shim of the present invention is divided into two main portions: a body

portion and an arm portion. The body portion is coupled to and connects two wave-shaped arms that extend longitudinally from the body portion. FIGs. 2A-5. The longitudinally extending wave-shaped arms define a slot 7 therebetween. *Id.*, para. 0048 and FIGs. 2A-5.

Importantly, and as can clearly be seen in the side view of the shim 16, as shown in FIG. 2B, the wave shape of the arms, which has well-defined peaks 12 and troughs 13, travels away from or towards the body portion. See also, instant specification, para. 0048.

As described in the first paragraph of page 21 of the specification of the instant application, the shim has an "elastic characteristic." By inserting the shim into a gap, the elastic shim will easily compress once inside the gap and will continue to place positive outward pressure on the gap well after it is put in place. First paragraph of page 21 and FIG. 3.

Claims 1 and 10 have been amended to further clarify these distinguishing features.

Hoh et al. discloses a shim with "longitudinal, parallel, narrow, grooves and ridges". Hoh et al., col. 3, lines 51-52. The grooves and ridges are present on the Hoh et al. shim only to "minimiz[e] any tendency of the stacked shims to shift laterally with respect to each other." Direct quote from Hoh et al., col. 3, lines 59-63. The lateral grooves and ridges are shown in FIGs. 1, 2, and 5 of Hoh et al. and run the entire length of the shim. These grooves and ridges are described by Hoh et al. as "striations" and **do not render the arms "wave-shaped" or "compressible"**. Because the "striations" are not used to place outward pressure on a gap, the Hoh et al. shim does not have an elastic characteristic. Furthermore, because the arms are not wave-shaped, they do not have peaks and troughs.

However, even if the Examiner maintains that the grooves and ridges of Hoh et al. are wave shaped, and do have peaks and troughs, the grooves run, as stated by Hoh

et al., "longitudinally," which, by definition, means that the **shape** of the wave must run perpendicular to the longitudinal axis. Therefore, Hoh et al. cannot show "the shape and direction of the wave of each arm traveling along the longitudinal extent," as recited in claims 1 and 10 of the instant application.

The Examiner cites 35 U.S.C. § 102(b) in these rejections. A proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated by Hoh et al.¹ Because the elements in independent claims 1 and 10 of the instant application are not taught or disclosed by Hoh et al., the shim of Hoh et al. cannot anticipate the present invention. Dependent claims 2-9 and 11-20 are believed to be patentable as well because they all are ultimately dependent on either claim 1 or 10. Accordingly, the present invention distinguishes over Hoh et al. for at least this reason. The Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. § 102(b) has been overcome.

(Page 5) Rejection under 35 U.S.C. §102(b), Colt

As noted above, the Examiner rejected claims 1-2 and 9 under 35 U.S.C. § 102(b) as being anticipated by Colt (U.S. Patent No. 1,552,912).

Amended claim 1 recites, *inter alia*:

...
arms...having a wave shape;...
the arms are of a thickness and of a material that allows them to compress and elastically return substantially to their initial wave shape after a compressive force is removed... (emphasis added)

Applicant again sets forth the argument that Colt discloses a solid **wedge-shaped shim** and not a "wave-shaped" shim. Compare Colt, FIG. 1 with FIG. 2b of the Instant application. There is a well-recognized difference between a "wave" and a "wedge" in the English language. Not only does one know the differences between

¹ See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

such structures. The Merriam-Webster online dictionary (<http://www.merriam-webster.com/dictionary>) defines a "wedge" as "a piece of a substance that tapers to a thin edge and is used for ...tightening by being driven into something", which exactly describes the Colt device. A "wave," on the other hand, is defined as "to follow a curving line or take a wavy form : UNDULATE... to swing (something) back and forth or up and down...2 : to impart a curving or undulating shape to".

The Examiner, on page 2 of the instant Office Action, responds to Applicant's arguments in the January 11, 2007 Response by alleging that the arm of Colt follows a curving line. Applicant submits that there is a significant difference between an arm that follows a curving line and an arm with a continuous "taper" and merely a rounded corner, as is the shape of Colt. Colt, page 2, lines 1-4 and FIGs. 1-10. It is, therefore, submitted that the definition of a wave in no way applies to or describes the Colt wedge-shaped shim.

In addition, the Colt wedge certainly doesn't have an "elastic characteristic," as does the present invention. Instant Specification, page 21. Therefore, the wedge shaped arms or Colt are not "of a thickness and of a material that allows them to compress and elastically return substantially to their initial wave shape after a compressive force is removed," as recited in amended claim 1 of the instant application.

The Examiner cites 35 U.S.C. § 102(b) in this rejection and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated.² Because the elements in Independent claim 1 of the instant application are not taught or disclosed by Colt, the shim of Colt does not anticipate the present invention. Dependent claims 2-9 are believed to be patentable as well because they all are ultimately dependent on claim 1. Accordingly, the present invention distinguishes over Colt for at least this reason. The Applicant

² See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

respectfully submits that the Examiner's rejection under 35 U.S.C. § 102(b) has been overcome and request that the rejection be withdrawn.

(Page 6) Rejection under 35 U.S.C. §103(a), Hoh et al.

As noted above, the Examiner rejected claims 18-19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Hoh et al. (U.S. Patent No. 4,232,068)³. Independent claim 18 has been amended to distinguish and to more clearly define the present invention over Hoh et al. Support for the changes is found in the first paragraph of page 21 of the specification of the instant application. No new matter has been added.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Amended independent claim 18 recites, *inter alia*:

... arms defining a slot there between and having a transverse extent and a longitudinal extent that is longer than the transverse extent and extending longitudinally from the body portion, each arm having a wave shape, the shape and direction of the wave of each arm traveling along the longitudinal extent and wherein the arms are of a thickness and of a material that allows them to compress and elastically return substantially to their initial wave shape after a compressive force is removed.

As stated in the section above, entitled "(Page 3) Rejection under 35 U.S.C. §102(b), Hoh et al.," Hoh et al. discloses a shim with "longitudinal, parallel, narrow, grooves and ridges". Hoh et al., col. 3, lines 51-52. The grooves and ridges are present on the Hoh et al. shim only to "minimiz[e] any tendency of the stacked shims to shift laterally with respect to each other." Hoh et al., col. 3, lines 59-63. The lateral grooves and ridges are shown in FIGs. 1, 2, and 5 of Hoh et al. and run the entire

³ Applicants make no statement as to whether such a combination is even proper.

length of the shim. These grooves and ridges do not render the arms "wave-shaped", as recited in claim 18.

Even if the Examiner maintains that the grooves and ridges of Hoh et al. are wave shaped, and do have peaks and troughs, the grooves run, as stated by Hoh et al., "longitudinally," which, by definition, means that the **shape** of the wave must run perpendicular to the longitudinal axis. Therefore, Hoh et al. cannot show "the shape and direction of the wave of each arm traveling along the longitudinal extent," as recited in claims 1 and 10 of the instant application.

It is accordingly believed to be clear that Hoh et al. neither shows nor suggests the features of claim 18. Claim 18 is, therefore, believed to be patentable over the cited art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 18.

(Page 7) Rejection under 35 U.S.C. §103(a), Hoh et al. in view of Grove Products

As noted above, the Examiner rejected claims 4, 8, 13, and 16 under 35 U.S.C. § 103(a) as being unpatentable over Hoh et al. (U.S. Patent No. 4,232,068) in view of Grove Products, Inc.⁴

The deficiencies of Hoh et al. are discussed above in the section entitled "(Page 4) Rejection under 35 U.S.C. §102(b), Hoh et al.", and are incorporated herein by reference in their entirety.

Grove Products Inc. manufactures a traditional shim that is a flat piece of material with a groove separating two arms. The Grove Products shim does not have "each arm having a wave shape" and "arms of a thickness and of a material that allows them to compress and elastically return substantially to their initial wave shape after a compressive force is removed."

⁴ Applicants make no statement as to whether such a combination is even proper.

When there is no suggestion or teaching in the prior art, the suggestion cannot come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP § 2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference Hoh et al. taken alone and/or in view of Grove Products, Inc. does not even suggest, teach or mention "arms defining a slot there between and having a transverse extent and a longitudinal extent that is longer than the transverse extent and extending longitudinally from the body portion, each arm having a wave shape, the shape and direction of the wave of each arm traveling along the longitudinal extent and wherein the arms are of a thickness and of a material that allows them to compress and elastically return substantially to their initial wave shape after a compressive force is removed" as recited in claims 1 and 10 of the instant application.

Accordingly, claims 1 and 10 distinguish over Hoh et al. taken alone and/or in view of Grove Products, Inc. Claims 4 and 8 depend from claim 1 and claims 13 and 16 depend from claim 10. Therefore, claims 4, 8, 13, and 16 are believed to be allowable as well.

For the foregoing reasons, independent claims 1 and 10, as amended, distinguish over Hoh et al. taken alone and/or in view of Grove Products, Inc. Claims 4 and 8 depend from independent claim 1 and claims 13 and 16 depend from independent claim 10. Since dependent claims contain all the limitations of the independent claims, claims 4, 8, 13, and 16 distinguish over Hoh et al. taken alone and/or in view of Grove Products, Inc. as well, and Applicant requests that the Examiner's rejection be withdrawn.

(Page 8) Rejection under 35 U.S.C. §103(a), Colt in view of Hartin

As noted above, the Examiner rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Colt (U.S. Patent No. 1,552,912) in view of Hartin (DES

423909).⁵

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In the section entitled "(Page 5) Rejection under 35 U.S.C. §102(b), Colt" above, the deficiencies of the prior-art shim disclosed in the Colt reference were discussed.

The Examiner cites Hartin. However, Hartin does not show, and the Examiner does not allege that it shows, the deficiencies of the Colt reference.

Claim 5 depends directly from newly amended claim 1. Independent claim 1 distinguishes over Colt in view of Hartin. Since dependent claims contain all the limitations of the independent claims, claim 5 distinguishes over Colt and Hartin, as well. The Applicant respectfully requests that the Examiner's rejection of claim 5 be withdrawn.

CONCLUSION

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Applicant acknowledges the continuing duty of candor and good faith to disclose information known to be material to the examination of this application. In accordance with 37 CFR § 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicant and the attorneys.

If the Examiner believes that there are any informalities that can be corrected by Examiner's amendment, or that in any way it would help expedite the prosecution of the patent application, a telephone call to the undersigned at (561) 989-9811 is respectfully

⁵ Applicants make no statement as to whether such a combination is even proper.

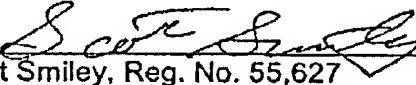
solicited.

The Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account 503,836.

In view of the preceding discussion, it is submitted that the claims are in condition for allowance. Reconsideration and re-examination is requested.

Respectfully submitted,

Date: May 21, 2007

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